

Attorney Docket No.

ISPH-0625

Inventors:

Brett P. Monia

Serial No.

10/057,550

Filing Date:

January 25, 2002

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1. (amended) An oligonucleotide 8 to 50 nucleotides in length which is targeted to mRNA encoding human c-raf and which is capable of inhibiting c-raf expression.

REMARKS

Claims 1-20 are pending in the instant application. Claims 2 and 3 have been withdrawn from consideration. Claims 1 and 4-14 have been rejected. Claims 15-20 have been objected to. Claims 2-5 have been canceled. Claim 1 has been amended. No new matter has been added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Election/Restriction

The gene transcripts listed in claims 1-4 have been subjected to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141. Applicant has elected to prosecute the invention of sequences that target and inhibit human c-raf transcripts. Accordingly, claims 2 and 3 have been canceled and claim 1 has been amended to recite antisense compounds targeted to c-raf.

II. Double Patenting

Claims 1 and 4-9 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-7, and 9-11 of U.S. Patent

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5,563,255. Claims 1 and 4-13 have also been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8 and 20 of U.S. Patent 5,952,229 in view of U.S. Patent 5,985,558. In both cases, the Examiner suggests that although the conflicting claims are not identical they directly anticipate or make obvious the instant claimed invention. Applicant is filing herewith a terminal disclaimer as required under 37 CFR 3.73(b) that applies to US Patent No's 5,563,255, 5,952,229 and 5,985,558. Accordingly, withdrawal of these rejections is respectfully requested.

Claim 5 has been rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,090,626. Applicant has canceled claim 5. Withdrawal of this rejection is respectfully requested.

III. Objection to Claims 15-20

Claims 15-20 have been objected to as being dependent upon a rejected base claim but the Examiner indicates they would be allowable if rewritten in independent form. Applicant has amended the claims from which claims 15-20 depend. Applicant believes this amendment will make these claims allowable based on the amendment to claim 1. Accordingly, withdrawal of this objection is respectfully requested.

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IV. Conclusion

Applicant believes that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

Respectfully submitted,

Jane Massey Licata

Jane Massey Licata
Registration No. 32,257

Date: November 13, 2002

Licata & Tyrrell P.C.
66 E. Main Street
Marlton, New Jersey 08053

(856) 810-1515

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Claims 2-5 have been canceled without prejudice.

Claim 1 has been amended as follows:

1. (amended) An oligonucleotide 8 to 50 nucleotides in length which is targeted to mRNA encoding human c-raf and which is capable of inhibiting c-raf expression.

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